UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
LIN, WEN TAI

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

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	Application No.	**Applicant(s)**
Office Action Summary	10/047,837	HIMMEL ET AL.
	Examiner	**Art Unit**	
	Wen-Tai Lin	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2002*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/16/02*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-39 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 2-4, 11-19 and 27-36 are rejected under 35 U.S.C. 112 second

paragraph as being indefinite because the following terms lack antecedent basis:

In claim 2,   "the electronic telephone directory";

In claim 3,   "the existing telephone number records";

In claim 4,   "the electronic telephone directory";

In claim 11,   "the web site";

In claim 14,   "the electronic telephone directory";

In claim 15,   "the web site";

In claim 15,   "the captor";

In claim 16,   "the means";

In claim 19,   "the password";

In claim 27,   "the communications terminal";

In claim 28,   "the electronic telephone directory";

In claim 29,   "the existing telephone number records";

In claim 29,   "the electronic telephone directory";

In claim 30,   "the communications terminal user";

In claim 30,   "the electronic telephone directory";

In claims 31-33 and 36,   "the communications terminal"; and

In claim 36,   "the means".

3.   Claims 1-20 are objected to because of the following issues/informalities:

4.   As to claim 1, it is noted that n step-a the destination address of the

communication terminal is recorded in a web browser. However, in step-c it states that

the computer capturing the telephone number records can be selected from a computer

running the web browser or a server hosting the web page. Thus it appears that

Applicant is assuming that the server must also have used a web browser to record the

destination address of the communication terminal. For prior art rejection in this office

action, the same assumption is being construed.

5.   As to claim 17, the limitation associated with the phrase "may be" is indefinite

because the claim language does not provides precise information as to whether the

associated action would be taken or not.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

7.   Claims 1-2, 5-12, 21-24, 26-28, 31-33, 35 and 37-39 are rejected under 35

U.S.C. 102(e) as being anticipated by Rossmann et al.[U.S. 20040111669].

8.   As to claims 1-2, Rossmann teaches the invention as claimed including: a

method for sending a telephone number record into a communications terminal [e.g.,

301, Fig.3] comprising:

a. recording in a web browser a destination address of the communications

terminal, the terminal having an automatic telephone directory [paragraph 85; e.g.,

recording the address of the telephone directory in a bookmark];

b. selecting one or more telephone number records to capture from a Web page

[paragraphs 44-45, 60-63, 68 and 78; e.g., saving a captured telephone in a PIM or a

telephone book, wherein the act of selecting one or more telephone numbers is

accomplished by invoking the related operations];

c. sending a message containing the one or more captured telephone number

records from a computer to the destination address of the communications terminal,

wherein the computer is selected from a computer running the web browser or a server

hosting the Web page [Abstract; note that in Rossmann's system either the browser of

the communication terminal or the servers 308 or 316 of Fig.3 can be used for scanning

the web page for information –see paragraph 85].

9.   As to claims 5-6, Rossmann further teaches that the communications terminal is

selected from a mobile telephone, a personal computer, a voice mail messaging

service, a FAX machine, a handheld computer, a personal digital assistant or

combinations thereof, wherein the communications terminal is selected from a device

that can store and retrieve information and is connectable to a telephone network [e.g.,

301, Fig.3 or 400, Fig.4].

10.   As to claim 7, Rossmann further teaches that the destination address for the

communications terminal is selected from a computer network address, an Internet

address or a telephone number [e.g., paragraphs 15 and 33-34; i.e., inherently the

wireless device must be provided with a network address of ID for communicating with

other servers in the network].

11.   As to claims 8-9, Rossmann further teaches that the one or more telephone

number records comprises a telephone number and an alphanumeric identifier for the

telephone number, wherein the telephone number record comprises parameters

selected from a telephone number, a contact name, an address, a FAX number, an e-

mail address, a hyperlink to a Web site, a business name, a business specialty,

business hours or combinations thereof. [paragraph 68; i.e., a telephone number can be

associated with the person's name and other attributes].

12.   As to claim 10, Rossmann further teaches that the step of recording the

destination address comprises:

       a. selecting a menu function on the browser for recording the communications

terminal's destination address;

       b. specifying the destination address on an interactive display provided by the

browser; and

       c. saving the destination address within the browser program.

[note that steps a-c are inherent procedures for recording a communications terminal's

destination address in a bookmark accessible by the browser].

13.   As to claim 11, Rossmann further teaches that the step of selecting the

telephone number record comprises:

       a. searching the Web site for the telephone number record to capture;

       b. viewing the Web page displaying the telephone number record to capture;

[note that steps a-b are accomplished at the stage when the user defines and chooses

elements of certain data type to capture]; and

c. choosing the telephone number record to capture, wherein choosing is

accomplished by means selected from clicking a mouse on a Web page button, marking

a box displayed on the Web page near the telephone number record, answering a query

contained in a dialogue box, other means compatible with the browser and server

software, or combinations thereof [e.g., paragraphs 89-90].

14.   As to claim 12, Rossmann teaches that the method further comprises d.

repeating steps a through c to select additional telephone number records [i.e., this step

is inherent in Rossmann's method because each additional telephone number record is

undergoing the same procedure performed by the browser/sever software].

15.   As to claims 21-24, 26-28, 31-33, 35 and 37-39, since the features of these

claims can also be found in claims 1-2, 5-7 and 9, they are rejected for the same

reasons set forth in the rejection of claims 1-2, 5-7 and 9 above.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

17.   Claims 3-4 and 29-30 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669], as

applied to claims 1-2, 5-12, 21-24, 26-28, 31-33, 35 and 37-39 above, further in view of

Official Notice.

18.   As to claim 3, Rossmann further teaches that the selected data type (such as

telephones) contained in a web page can be extracted and stored in a telephone book

via a set of user selected operations.

        Rossmann does not specifically teach that the selected operations include

searching the existing electronic telephone directory to see if the number to be entered

already exist or not, and if it does, then notify the user of the existence.

        However, Official Notice is taken that this additional feature is well known in the

art. For example, a user is warned when an attempt to overwriting a record of a file is

made. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to follow this conventional procedure to update Rossmann's

telephone directory because the procedure ensures the integrity of the directory.

19.   As to claim 4, Rossmann does not specifically teach how a telephone record in

the telephone directory is updated (e.g., deleting, adding, or modifying a record).

        However, Official Notice is taken that the listed feature is a typical procedure in

the art of updating a database and as such it can be applied to updating a telephone

directory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adopt the conventional database updating procedure in updating Rossmann's system/method because such procedure ensures the integrity of Rossmann's telephone directory.

20.   As to claims 16 and 29-30, since the features of these claims can also be found in claims 1, 3-4 and 27, they are rejected for the same reasons set forth in the rejection of claims 1, 3-4 and 27 above.

21.   Claims 13-15, 17-20, 25, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669], as applied to claims 1-12, 21-24, 26-33, 35 and 37-39 above.

22.   As to claims 13-14, Rossmann further teaches that the telephone number record comprises a telephone number and an alphanumeric identifier for the telephone number [e.g., the telephone owner's name], the method further comprising:

d. editing the alphanumeric portion of the chosen telephone number record, wherein the editing better identifies the telephone number;

e. editing the telephone number portion of the chosen telephone number record [see the rejections of claims 7-8 above]

Rossmann does not specifically teach that the editing makes the telephone

number compatible with the communication terminal's telephone system and displayed

in a standard format suitable for a format of the electronic telephone directory.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to edit the telephone number compatible with Rossmann's

communication terminal (which is a cellular phone) and displayed in accordance with

the PIM or telephone book's format because by doing so the stored phone numbers can

be made directly usable as they are stored.

23.   As to claim 15, Rossmann further teaches that the step of selecting the

telephone number record comprises:

    d. searching the Web site for the telephone number record to capture;

    e. viewing the Web page displaying the telephone number record to capture;

    f. choosing the telephone number record to capture [see the rejections of claims

7-8 and 13 above],

Rossmann does not specifically teach that choosing is accomplished by

instructing the browser to display a telephone number record dialogue box, and copying

information from the Web page into the dialogue box by the captor.

However, Rossmann teaches that a menu of certain related operations could be

provided in the browser application in a standard location [paragraph 90]. Since

Rossmann's approach for choosing the telephone numbers can be accomplished by

devising the related operations, it is obvious that using a dialogue box is a design option because the dialogue box provides well known interactive interface for the user.

24.   As to claim 17, Rossmann teaches that the computer is the server hosting the Web page [paragraphs 85-87]. Rossmann does not specifically teach requesting a credit card number by the server, wherein the cost of a long distance telephone call to dispatch the message may be charged.

However, charging a communication terminal for the cost of long distance telephone call is well known in the art. For example, an ISP server may charge its client for connecting to the internet via long distance telephone calls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to introduce a billing request, which can typically be paid through a credit card, when Rossmann's long distance call is involved for connecting Rossmann's terminal device and web page host server because it is reasonable to pass whatever service charges onto the end users.

25.   As to claims 18-19, Rossmann does not specifically teach marking the message with a password which is recorded on the browser with the destination address of the communications terminal, and determine that the message contains a telephone directory record, discarding the message if the message is not marked with a password.

However, it is well known in the art of secured communication by marking a message with a password.

It would have been obvious to one of ordinary skill in the art that Rossmann's message needs to be securely communicated to the terminal devices because by doing so it enhances the integrity of the local telephone directory by safe guarding the updating procedure with password detection.

26.   As to claim 20, Rossmann does not specifically teach that by the communications terminal, the method further comprises: determining that the message contains a telephone directory record, providing notification that the message has arrived at the destination address.

However, it is obvious that, rather than stored locally, Rossmann's PIM or telephone directory could have been stored elsewhere in the network. Under such circumstances, it would have been obvious to one of ordinary skill in the art that Rossmann's extracted telephone numbers have to be sent to a remote network node (such as a server) via a message containing telephone records, and therefore, notification of the message's arrival at the destination node is an obvious approach because it enables the sender to know whether the telephone numbers have been received, or otherwise a new attempt for sending the telephone numbers can be invoked.

27.   As to claims 25, 34 and 36, since the features of these claims can also be found in claims 1, 11, 13, 16, 21 and 27, they are rejected for the same reasons set forth in the rejection of claims 1, 11, 13, 16, 21 and 27 above.

28.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

     Sheha et al. [U.S. 20030078035];

     Jandel et al. [U.S. 6097793];

     Crandell et al.   [U.S. 20040240642]; and

     Baumgartner et al. [U.S. 20050022115].

29.   A shortened statutory period for response to this action is set to expire 3 (three)

months and 0 days from the mail date of this letter. Failure to respond within the period

for response will result in ABANDONMENT of the application (see 35 U.S.C. 133,

M.P.E.P. 710.02, 710.02(b)).

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the

references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the contest of the passage as taught by the prior art

or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

May 15, 2005